Supreme Court, U.S.
FILED
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No.

In the Supreme Court of the United States

LU SORO d/b/a CITIGROUP, *Petitioner,*

versus

CITIGROUP,

Respondents.

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
For The Eleventh Circuit

PETITION FOR WRIT OF CERTIORARI

Luis Soro President
CITICORP MORTGAGE CO. INC.,
INVENTOR, CREATOR, DESIGNER.
FABRICATOR, DEVELOPER,
CULTIVATOR, AND THE FIRST
USER OWNER SINCE JANUARY 05,
1976 THE TRADENAME CITIGROUP
MORTGAGE COMPANY
P,O, Box 398142
Miami Beach, Fl. 33239-8142

(786) 512-2828
(305) 531-4000

QUESTIONS PRESENTED

A Whether the Lower Courts failed to realize that this Supreme Court of the United States recognized there is no such thing as property in a trademark except as a right appurtenant to an established business or trade in connection with which the mark is employed. Respondent first use was over 22 years after Petitioner's invented and first use in interstate commerce.

B Whether the Lower Courts erred when they failed to understand that the right to a particular mark grows out of use, not its mere adoption. If you do not use the mark, you cannot possibly have any rights to that particular mark.

C Whether the Lower Courts failed to observe that the Respondent realized that their prior registration did not cover this new name. They had never used this new name in commerce. The trademark office realized that Respondent needed a new registration and complied with the request, due to the facts that the two are different and the very clear TTAB law use it or lose it.

D Whether the Lower Courts erred because they did not apply the doctrine of first use to the

name Petitioner invented, created, developed, cultivated, and the original first user owner of Citigroup, and failed to realize that a federal registration is not needed for a particular mark to establish right to that mark, by the Petitioner, (22) twenty two years of prior use, cancellation should be ordered.

E Whether the Lower Courts erred when they failed to observe that confusion between service marks and similarity of appearance is determined on the basis of the total effect of the designation rather than on a comparison of individual features.

F Whether a failed and insolvent company should be allowed to use the TARP money to pay for attorneys to file papers in a court action, over a dispute over a name, at taxpayers' expense, despite the fact that it will not be in business very much longer before the Fed puts them into receivership, and forces them out of business.

PARTIES TO THE PROCEEDING

The following, and no others, are parties to the instant proceedings:

Petitioner Lu Soro, an individual, and the inventor, creator, developer, and the original first user owner of the trademark Citigroup since January 05, 1976 – used in interstate use since the same date.

Respondent is believed to be a Delaware corporation that hijacked Petitioner's trademark on October 8, 1998, and on November 21, 2000, was fraudulently registered at the trademark office. This Petitioner has been to every court in the country to have this registration cancelled.

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PETITION FOR WRIT OF CERTIORARI

Petitioner respectfully seeks certiorari to review the opinion by the Eleventh Circuit Court of Appeals entered July 07, 2008. [Appendix B] and a timely submission of a Petition for Rehearing was denied on August 28, 2008. [Appendix A]

I. CITATIONS TO OPINIONS BELOW

The Opinion of the Eleventh Circuit Court of Appeals in Lu Soro d/b/a Citigroup versus Citigroup (not selected for publication in the Federal Reporter) July 07, 2008 [Appendix B page 2].

The Order denying the Petition for Rehearing was entered on August 28, 2008. [Appendix A], the Judgment that was entered by the District Court of Southern Florida on July 17, 2007, also unpublished [Appendix D page 11] and the Motion for Reconsideration that was denied on August 7, 2007, [Appendix C page 8]. The pertinent rulings appear in the attached as noted.

II. JURISDICTIONAL STATEMENT

The District Court for the Southern District of Florida had subject matter

jurisdiction pursuant to Section 43 (a) (1) of the Lanham act of 1946, 15 U.S.C.

1125 (a)(1) unfair competition under Florida common law, and injury to business reputation under Florida Statutes 495. 151, this being an action for dilatory relief due to the facts Respondent hijacked Petitioner's thirty three year old trade name and Fraudulently registered it at the U.S. Patent and Trademark Office.

On July 17, 2007, without any type of oral presentation the District Court closed the case after the Respondent filed a motion to dismiss the case. Every rule in trademark law and first use of a trademark was violated by the District Court when the judge did not hear any argument. [App. D]

Petitioner Lu Soro d/b/a Citigroup since 1976, appealed the District Court's order to the Eleventh Circuit Court of Appeals pursuant to 28 U.S.C. 1291 that had jurisdiction over all final decisions of the district courts of the United States.

A timely Motion for Reconsideration was filed with the District Court to point out that the Petitioner was the inventor, creator, and original first user owner of the mark Citigroup,

and a Federal registration is not needed to have and establish rights to a particular mark. It was also filed to point out that a right to a particular mark grows out of use and not its mere adoption. If you do not use a name, you do not have any rights to that particular name. Wal-Mart – Wal-greens, Office Depot-Office Max, Super Man – Super Dog – Super Cuts – Super glue, Goodyear tires – Goodrich tires, Blackberry, Blackman, Blackboard, Citigrada – citijunk-citigroup-citilab, Bigfoot – bigfish – bigwheel – bigfive - big brother - bighorn, Hawaiian tropic – Hawaiian airlines – Hawaiian telecom-Hawaiian time.

Every book in the library written in English contains the same thing: words in different combinations that use the same 26 letters. Those same 26 letters will be used to create and recreate words, some of them new, without any meaning until one is given. A user of a similar name cannot come 20 years later and start to use a name of another. Sun Bank-Sun Federal Bank. Sun America Bank – Sun Mortgage Bank. General Motors-General Tire-General Electric-General Store.

III. CONSTITUIONAL AND STATUTORY PROVISIONS INVOLVED

The First Amendment to the United States Constitution:

Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the government for a redress of grievances.

The Fourteenth Amendment to the United States Constitution, Section 1:

Section 1. All persons born or naturalized in the United States and subject to the jurisdiction thereof, are citizens of the United States and of the state wherein they reside. No state shall make or enforce any law which shall abridge the privileges or immunities of citizens of the United States; nor shall any state deprive any person of life, liberty, or property, without due process of law; nor deny to any person within the jurisdiction the equal protection of the laws.

IV. STATEMENT OF THE CASE

A. Summary of Facts

Petitioner Lu Soro is the registered and licensed president and sole shareholder of the licensed and registered company Citicorp Mortgage Company Inc. since it was incorporated on July 07, 1981, a licensed mortgage broker and owner since it was formed on December 15, 1979.

Petitioner Lu Soro is the creator, inventor and the original first user owner of Citigroup Mortgage Company since it was manufactured on January 05, 1976 and has never been incorporated to this date.

Petitioner Lu Soro made his first mortgage loan over (40) forty years ago on March 1965 and has made over 15,000 loans since, over 11,000 mortgage loans using the Citigroup tradename since 1976 throughout the world.

The Eleventh Circuit Court of Appeals affirmed the opinion of the lower court, and did not take into consideration the facts that the Trademark Office issued a separate registration for Citigroup on 11-21-2000.

The tradename Citigroup invented and cultivated by Lu Soro that did not mean anything until I gave it a meaning is as close to Respondent's mark Citicorp as Wal-Mart is to Wal-greens, as Goodyear tires is to Goodrich tires, as General Motors is to General tires and to General Electric, General Mills, General Rental, General Nutrition, as American Airlines is to American Express, American Cargo Express, American Red Cross, American Coin Exchange, American Cancer Society, and American Heart Association.

The name citigrada and citigrade are found in the dictionary that have nothing to do with Respondent or Petitioner. The Petitioner has found over (3000) three thousand "citi" users since 1976 all over the United States and beyond, that have nothing to do with the Respondent or Petitioner and the lawyer for the Respondent agrees with the Petitioner that "citi use is not new." Petitioner has innumerable (∞) business owners that use the mark cities, city, cit in their tradenames.

The word city or cities is a noun describing a place or a thing. Phonetically, cities is the plural of city, and the fact that we have traditionally tolerated a greater degree of resemblance among the names of financial institutions only reinforces this conclusion.

This Supreme Court of the United States recognized over (70) seventy years ago that there is no such thing as a property in a trademark except as a right appurtenant to an established business or trade in connection with which the mark is employed. Use it or lose it should be a guiding principle for trademark owners, and the right to a particular mark grows out of use, not its mere adoption.

The Honorable Joan A. Leanard wrote in her opinion "as it is undisputed that Soro has been using the name Citigroup name since at least the mid 1990's" based on case facts, meaning 1994-1995, giving Lu Soro "FIRST USE." The district court misapprehended the law and that is reviewed under the clearly erroneous standard of Fed. R. Civ. P. 52 (e).

Respondent's own attorney in a signed declaration and after being warned that willful false statements and the like so made were punishable by fine or imprisonment or both under U.S.C. 1001, and that such willful false statements may jeopardize the validity of this document, Stated on June 15, 2000 "the mark was first used on the goods or services anywhere at least as early as April 6, 1998 and in commerce at least as early as October 8, 1998." Signed by Anne Moses, Assistant Secretary.

The Eleventh Circuit rejected Lu Soro's repeated claims that he was the first user of the mark "Citigroup" and had a right to the term. They also wrote "these contentions are not relevant to the issue of this case." First use is very relevant to a trademark case because first use or senior use gives ultimate rights to the use of that particular mark. Use is not only essential to establishing rights in a particular mark, continued use is essential to preserving rights in a mark. No Use, No Rights.

In determining likelihood of confusion in service marks, similarity of appearance is determined on the basis of the total effect of the designation rather than on a comparison of the individual features, between service marks, and a federal registration is not needed for a service mark to establish rights.

Petitioner has twenty two (22) years prior use of his invented tradename before Respondent hijacked the mark Citigroup on October 8, 1998.

Respondent is confused, thinking they have a monopoly on the use of city, when in fact this Petitioner has found over (3000) three thousand "citi" users worldwide that are not associated or have anything to do with Respondent. The evidence is very clear and

without any doubt that the marks Citigroup and Citicorp are not even closely related or even associated with each other. That is why the Patent and Trademark Office issued a different registration for Citigroup on November 21, 2000, than the registration they had for Citicorp. They have admitted the two marks are different, and the Trademark office agreed with them. The two marks are world apart. Wal-mart, Wal-greens, Microsoft, Microhard, Microtel, Microsharp, Office Depot, Office Max, Office Supply, Goodyear Tires, Goodrich Tires, Goodman Tires, Gooduse Tires.

The Respondent ascertained that the two marks are not confusingly similar and requires a separate registration, the Respondent admits to not doing any trademark search, for the mark Citigroup, and that is the reason for this law suit: for damages, and to cancel the registration. The prior judgment and the subsequent registration of a totally different mark are not related and far from identical. This petitioner has found a company called Citgroup and is placed next to Respondent.

REASONS FOR GRANTING THE PETITON

A. Summary of Argument

The Eleventh Circuit's opinion in this case is a study in contradiction and an utter rejection of this Court's and other court's clearly established principles of trademark and First Amendment law. See Moseley v. V. Secret Catalogue Inc. 123 S. CT. 1115 (Mar. 04, 2003).

It is a well established law that first user or inventor or creator has the ultimate rights to that name. It is also a well established and undisputed fact that we have traditionally tolerated a greater degree of resemblance among the names of financial institutions. Sun Banks v. Sun Federal 651 F.2. 331 (5th Cir. 1981), First Southern Federal v. First Southern Savings 614 F. 2d. 71 (5th Cir. 1980), Fidelity Bond v. Fidelity Bond (37 F. 2d 99 5th Cir. 1930). Del v. Clark.

The Respondent, which is an insolvent shell of a financial institution and is on U.S. Government life support at taxpayers' expense and will be nationalized any day, should not be permitted to hijack this name. Home Savings v.

Home Savings of America. The lower court judge agree with this Petitioner he was the first Citigroup user. Continental Bank Corp v. The State of Florida Supreme Court 87-1955

A THIS SUPREME COURT OF THE UNITED STATES RECOGNIZED THERE IS NO SUCH THING AS PROPERTY IN A TRADENAME OR TRADEMARK EXCEPT AS A RIGHT APPURTENANT TO AN ESTABLISHED BUSINESS OR TRADE IN CONNECTION WITH WHICH THE MARK IS EMPLOYED

Use it or lose it should be a guiding principle for tradename or trademark users or owners. Delaware & H. Canal Co. v. Clark, 13 Wall. 311, 322, 20L. ed 581, 583; Mcleanv. Fleaming, 96 U.S. 245, 254, 241. ed. 828, 832. This Supreme Court of the United States recognized over (70) seventy years ago there is no such thing as property in a trademark except as a right appurtenant to an established business or trade in connection with which the mark is employed. Surf Club v. Tatem Surf Club Inc.,

Respondent cannot possibly have any rights to the name Petitioner invented, created, manufactured, developed, fabricated, and has cultivated since January 05, 1976. The right to a particular mark grows out of use, not its mere

Adoption. Respondent has Fraudulently adopted petitioner's tradename and this Court should order them to cease and desist from using the name "Citigroup" immediately and destroy all documents bearing the Citigroup name and pay Petitioner treble profits since October 08, 1998. Moseley v. V. Secret Catalogue Inc., 123 S. Ct. 1115 (Mar. 04, 2003).

The courts below in this case have completely disregarded the entire set of issues on First Amendment procted activity to effectively prohibit an entire category of speech in a public forum, first use of and invented and created tradename, and all of the factors presented in this case clearly favor the Plaintiff, based on common law competition and statutory law, and injury to business reputation as the Respondent is insolvent and will close.

Although the decision is unpublished, the Eleventh Circuit should not be allowed to use the mechanism of an unpublished decision to completely disregard the well established principles of the First Amendment law, and the First User or inventor or creation of a tradename, that has been used in interstate commerce and trade since January 5, 1976.

B A FEDERAL REGISTRATION IS NOT NEEDED FOR A MARK TO ESTABLISH RIGHTS TO A PARTICULAR MARK

Appellant contended on appeal that because he was the inventor, creator, manufacturer, designer, fabricator, cultivator, and the original first user owner of CITIGROUP Mortgage Company since January 5, 1976 that he had ultimate rights to the term "Citigroup." Appellant also contended that not even with gargantuan speculation, would he have been able to predict in 1976, the Respondent would start using a different name in 1998 that they had never used before. In Trademark law, a company or person must have continuous use of the mark and the rights to a particular mark grow out of use not its adoption. Home Savings of America, also Continental Bank Corp., v. The State of Florida 87-1955, then on October 8, 1998, the Respondent hijacked Petitioner's trademark.

Use it or lose it should be a guiding principle for tradename or trademark users or owners. Delaware & H. Canal Co. v. Clark, 13 Wall. 311, 322, 20L.ed 581, 583; Mclean v Fleaming, 96 U.S. 245, 254, 241.ed. 828, 832. This Supreme Court of the United States

recognized over (70) seventy years ago there is no such thing as property in a trademark except as a right appurtenant to an established business or trade in connection with which the mark is employed.

Respondent cannot possibly have any rights to the name Petitioner invented, created, manufactured, developed, fabricated, and has cultivated since January 05, 1976. The right to a particular mark grows out of use, not its mere Adoption. Respondent has Fraudulently adopted Petitioner's tradename and this Court should order them to cease and desist from using the name "Citigroup" immediately and destroy all documents.

First User has ultimate rights to a name and reasonable people know the difference between Wal-Mart and Wal-greens, Office Depot and Office Max, General Motors and General Electric and General Tire etc.

Respondent cannot possibly have any right to a name they started using over twenty two (22) years after Petitioner invented and created his tradename that has been used in international trade since January 5, 1976.

Most Names or tradenames are not registered, in fact an attorney from the

trademark office wrote in a published newspaper "If every name in America was trademarked we would need twenty buildings like these." He was referring to the twin 14 story towers in Crystal City, Va. That is why First user has ultimate rights no matter who the litigants are.

C IN TRADEMARK LAW THE FIRST USER HAS ULTIMATE RIGHTS TO THAT TRADENAME WHETHER IT IS REGISTERED WITH THE TRADEMARK OFFICE OR NOT.

The law of trademarks is but a broader law of unfair competition; the rights to a particular mark grows out of its use, not its mere adoption; and is not the subject of property except in the connection with an existing business. The Respondent invaded Petitioner's home state nine years after first use of Citigroup by the Petitioner, and started using his name twenty two (22) years after its creation and use in international trade. As part of the events that have occurred since October 8, 1998, Respondent has also hijacked part of Petitioner's Logo, the Crescent moon (⊂) that now Respondent uses and claim to use it as an umbrella.

Use is essential to trademark protection. You have to use it or you lose it. Use is not only essential to the establishing of rights in a tradename, the continued use is essential to preserving rights in a tradename. The Respondent does not have any rights to Petitioner's invented name and should be Ordered to be cancelled by this Court. Respondent has had fraudulent use of Petitioner's mark Citigroup since October 8, 1998.

D CANCELLATION OF THE REGISTRATION FOR THE MARK CITIGROUP OBTAINED ON NOVEMBER 21, 2000, NUMBER 2406753 SHOULD BE ORDERED BY THIS COURT.

The Fraudulently obtained registration of the mark Citigroup on November 21, 2000 should be ordered cancelled at the Trademark office. Petitioner on November 22, 2000, one day after Respondent fraudulently registered his mark filed a cancellation case number 31,572 at the (PTO) for the mark Citigroup. The name or tradename is a valuable asset because it is the "good will" of a business. The Petitioner has (33) thirty three years of good will in Citigroup and (22) twenty two years of prior use of the

Citigroup mark before Respondent's first use on October 8, 1998 [Appendix E].

In general, the scope of a trademark search varies widely. It can include one or all of the following: phone books (major cities), state registrations, market directories, domain names, trade listings. The clearing of a mark for use is one of the most difficult aspects of trademark practice. Respondents claim that they "DID NOT DO ANY TRADEMARK SEARCH BECAUSE THERE WAS NO TIME." This is where the problem starts. Since 1976, Petitioner has checked 411 and the phone books and until 1998 not one Citigroup user was found, although over (3000) three thousand "citi" users have been found. Even in the dictionary citigrade and citigrade are found. Generally, it is advisable to do a full search. Respondent has spent thousands of dollars on this case and not a dollar on trademark or tradename search because they knew of Petitioner's prior use of the tradename Citigroup. This Petitioner has spent a gargantuan amount of time and money defending his tradename that has been used for the past (33) thirty three years in international trade, that have been continuous. Judge Leanard's ruled "As it is undisputed that Soro has been using the 'Citigroup' name since at least the mid 1990's..." That gives Lu Soro "First Use with Ultimate Rights." Delaware & H. Canal Co. v. Clark 13 Wall. 311, 322, 20 L.ed. 681, 583

Moseley v. V. Secret Catalogue Inc., 123 S. Ct. 1115 (Mar. 04, 2003).

E THE LOWER COURTS ERRED WHEN THEY FAILED TO OBSERVE THAT FIRST USE GIVES ULTIMATE RIGHTS, AND NO CONFUSION IS MADE, WHEN COMPARED TO INDIVIDUAL FEATURES, NO SUCH THING AS PROPERTY IN A MARK

The Lower Court erred when they failed to observe that confusion between service marks and similarity of appearance should be determined on the basis of the total effect of individual features. These two marks cannot be said to be closely related due to the massive third party use that has nothing to do with either party in this case. The argument is will a customer be able to tell the two names apart? See General Motors - General Electric – General Mills – General George Washington – General George Patton – General David Petraeus – General Counsel – General Hospital – General Foods – General Contractor – General Dynamics – General Anesthesia – General Dollar. This will show this Honorable Court that all these names are very different although they all are similar in appearance. This

is the same issue that has occurred in the instant case, and should be corrected.

This Petitioner has many more examples of similar names that do business side by side every day, and will provide them upon request, or in oral argument before this Court. This Court by reversing the Lower Court's opinion will save time and money for hundreds of companies and owners. There is no such thing as property in a trademark except as a right appurtenant to an established business in connection to trade.

It is a well established law that first user or inventor or creator has the ultimate rights to that name. It is also a well established and undisputed fact that we have traditionally tolerated a greater degree of resemblance among the names of financial institutions. Sun Banks v. Sun Federal 651 F.2. 331 (5th Cir. 1981), First Southern Federal v. First Southern Savings 614 F.2d. 71 (5th Cir. 1980), Fidelity Bond v. Fidelity Bond (37 F.2d 99 5th Cir. 1930).

Respondent had not yet even initiated the registration of Citigroup in 1976 and did not use the mark Citigroup until October 8, 1998. There is no genuine issue of material facts that Citicorp and Citigroup, Citi Loc, Citicare,

Citicruiser, Citimotors, Citidance, Citiride, Citideli, Citistar, Citipawn, Citiauto, Citiloans, Citipool, Citibay, Citiroof, Citistate, Citicap, Cititoy, Citiedge, Citicorner, Citigalss, Citiexpress, or Citicenter are associated or have anything to do with Citicorp or any other name Respondent has used. Trademark laws requires examination of the similarity or dissimilarity of the marks in their entierities as to appearance, sound, connotation, and commercial impression.

As a consequence, the trademark Office issued a registration number for Citigroup that is different to the Citicorp one. The two marks are worlds apart.

F. A FAILED AND BANKRUPT BANK THAT THE FEDERAL GOVERNMENT HAS BEEN FORCED TO PROP UP WITH MONEY FROM TARP, SHOULD NOT BE PERMITTED TO USE THAT MONEY THAT BELONGS TO THE TAXPAYERS TO PAY A LAWYER TO HIJACK ANOTHER BUSINESS' MARK.

The Respondent in this case is in ruins and has failed is an ongoing concern. The Federal Government has been forced to give

money to the Respondent because they are insolvent. This money that the U.S. Government gave was intended to save this bank from failure. This Bank is so insolvent that the Federal Government will have to Nationalize them, and force them out of business. The TARP money should not be permitted to be used to pay lawyers to file papers for them in court to steal Petitioner's (33) thirty three year old mark. The Respondent is on U.S. Government life support at taxpayers' expense and are on the path of a turbulent descent.

The Respondent in this case is insolvent and this High Court has the chance to make sure that taxpayers' money is used in the proper form and the way it was intended by Congress. If the Federal Government has done a quite technical nationalization of the Respondent, this court should return the Petitioner's name, as the Respondent will not be in business to use it.

VI. CONCLUSION

Petitioner contends that in a number of ways, the Eleventh Circuit's opinion in this case conflicts with the precedent set by this Court and that of the other circuits, creating a decision that is fundamentally wrong and that severely chills the rights of those who engaged in what has consistently been held to be First Amendment protection and protected speech activity and the right of first use of an invented, created, and the cultivation of a (33) thirty three year old tradename, and improperly upholds a law that substantially restricts First Amendment Protected activity in public forums.

If the Respondent requested from the Trademark Office a different registration number for the mark Citigroup from the mark they had, and the Trademark Office upon examination of the application and the mark granted a different registration number for Citigroup than the one they had for Citicorp, the only conclusion that a reasonable person can determine is that both of the marks in questions do not have any conflict, despite any conclusion the lower court might have had for whatever reason. This Court must order the Trademark Office to cancel registration number 2406753 issued November 21, 2000, and award Petitioner all the damages he has.

DATED: FEBRUARY 18, 2009

RESPECTFULLY SUBMITTED,

Luis Soro, President
CITICORP MORTGAGE CO., INC.,
INVENTOR, CREATOR, DESIGNER,
FABRICATOR, DEVELOPER,
MANUFACTURER, CULTIVATOR, AND
THE ORIGINAL FIRST USER OWNER
SINCE JANUARY 05, 1976 OF THE
TRADENAME CITIGROUP MORTGAGE
COMPANY

P.O. BOX 398142
MIAMI BEACH, FL 33239-8142

(786) 512-2828
(305) 531-4000

Exhibit A

EXAMPLES OF

MASSIVE

"CITI" USE.

Appendix A
Eleventh Circuit Defined Petition 1

Appendix B
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Appendix C
District Court Order Denying Motion For Reconsideration 9

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Appendix E
Respondent's statement of Use to The United States Patent and Trademark Office April 18, 2000, declaring first use of Citigroup as early as April 6, 1998, and in commerce at least as early as October 8, 1998, deposited "Express Mailing Label No. TB319294228 U.S. June 15, 2000 27

Exhibit A

CITI OF BALTIMORE, CITI KNITS, CITI LOC, ADVANCE CITI MORTGAGE CO., LIBERTY CITI LOCK & KEY, CITI TANNING SALON, MAGIC CITI CARPET, FLORIDA CITI DINNER, BARRICADE CITI, CITI TECHNOLOGIES, CITIVIEW APT., CITITEAM, LIBERTY CITI SHOE REPAIR, CITI RECORDS & TAPES CITIDANCE, MAGIC CITI MOTORS, CITI MORTGAGE BANK OHIO, CITICARE CENTER & REHAB, CITI NETWORK SPECIALISTS, CITI INFORMATION CENTER, CITI GLOBAL CENTER, CITI FORMAL WEAR, CITI ROCK INDUSTRIES, CITI WASTE GROUP, CITIBYTE, CITI ENTERTAINMENT, CITI PAPER SUPPLY, CITI ROOF REPAIR, CITI RIMS, CITI MED GROUP, MAGIC CITI LOCK & KEY, CITI HEALTH CENTER, GOLD CITI, CITI 411, CITI SHEET METAL, CITI LENDING COMPANY, CITI LIQUIDATORS, CITISTAR FINANCIAL GROPU, CITI STATE HOME REPAIR, CITI VIEW DELI, GOLDEN CITI CASH JEWELERY, CITI PRODUCTS, ALL CITI MORTGAGE COMPANY, CITI INFORMATION ANALYSIS, CITI INSPECTION SERVICE, CITI HAIR SALON, NEW CITI JEWELERS, CITI MORTGAGE INVESTMENT, CITI

PALM & CARD READING, CITI AIR CONDITIONING SERVICE, CITI ZONE FLOWER SHOP, CITI POINTE, CITI COMMUNICATION SERVICE, CITIFACTORS FINANCIAL GROUP, MURAL CITI, MAGIC CITI MOVERS, CITI DELIVERY SERVICE, CITISTATE AUTO PARTS, CITITRACK, CITI EXOTIC DANCERS, CITI CASKET CO. CITIMOBILE HOME PARK, CITI BOAT REPAIR, CITI SOAP COMPANY, CITI OXYGEN REFILLS, CITI BAY, CITICRUISER.
CITI INTEGRATING CO. CITISHIPPING CO., CITI COMPONENTS, CITI SCIENTIFIC SUPPLIES, CITI EMBROIDERY, MAGIC CITI TATTOO, 1ST CITI, BALLOON CITI, CITIOPTICAL, CITIMETER CO., EDMERAL CITI JEWELERY, VINCITI NETWORKS, HUB CAP CITI, CITI GRAPHIX GROUP, CITI NOTIONS, CITI DATA RECOVERY, CITI TOOL COMPANY, CITIHEAT & AIR, MODEL CITI, BIG CITI MEN'S CLOTHING, CITI SICKROOM SUPPLY, CITI MASSAGE SALON, MAGIC CITI PAWN, ANGELCITI.COM, CITI MODELING CENTER, CITI EXPRESS, CITI SPRINKLERS, CITI MATERNITY SHOP, CITIPANELING DISTRIBUTORS, CITISPACES, CITITEAM, CITIHYTEC, CITIWALK, TELECITI CITIMAS, MAPCITI., AUTOCITI, CITIBEST,

CITICOLORS, CITIWELDING, CITISOD, TICKETCITI, PAPERCITI, SOUNDCITI, BOATCITI, CITIPRINT, CITISTATE AUTO GLASS, CITIZONE GRILL, CITIAUTO GLASS, CITIUNIFORMS, CITIBOX COMPANY, CITISTONE, CITIPLANT FARM, CITI TENNIS CENTER, CITICHEMICALS, CITIBOAT CHARTER, CITIWIG STUDIO, CITIBAG COMPANY, CITIFORTUNE TELLER, CITI PACKINGCOMPANY, CITIPRODUCTS, CITIDEMOLTION, CITI EXCAVATIONS, CITICONSTRUCTION, CITIEXCHANGE, CITIZONE RADIO, CITIHOME SECURITY, CITICORNER SPORTS, CITITUX GALLERY, CITIEDGE DELI, CITISWINGERS, CITIEDGE

This Plaintiff has hundreds more citi users found since 1976. A total of 3027 citi users found, millions more uses cities, city, cit.

IN THE UNITED STATES COURT OF APPEALS FOR THE ELEVNTH CIRCUIT

No. 08-10248-HH

LU SORO d.b.a Citigroup,
Plaintiff-Appellant,

versus

CITIGROUP,
Defendant-Appellee.

On Appeal from the United States District Court for the Southern District of Florida

---

BEFORE: TJOFLAT, BLACK and WILSON, Circuit Judges.

PER CURIAM:

The appellant's motion for reconsideration, which is construed as a petition for rehearing, is DENIED.

ENTERED FOR THE COURT:

_____
UNITED STATES CIRCUIT JUDGE

IN THE UNITED STATES COURT OF APPEALS

FOR THE ELEVENTH CIRCUIT

No. 08-10248
Non-Argument Calendar

D.C. Docket No. 06-61449-CV-PAS

LU SORO
d.b.a. Citigroup,

Plaintiff-Appellant,

versus

CITIGROUP,

Defendant-Appellee.

Appeal from the United States District Court for the Southern District of Florida

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(July 7, 2008)

Before: TJOFLAT, BLACK and WILSON, Circuit Judges.

PER CURIAM:

Lu Soro d/b/a Citigroup ("Soro"), proceeding pro se, appeals the district court's dismissal, on the grounds of res judicata and collateral estoppel, of his complaint, which sought to overturn the Trademark Trial and Appeal Board's ("TTAB") denial of his petition for cancellation of defendant Citigroup's federal registration of the CITIGROUP mark, 15 U.S.C. $ 1071(b)(1), (4)..

Soro argues that neither res judicata nor collateral estoppel applied to the claims he raised in the district court. Soro contends that because different issues arise in infringement proceedings and cancellation proceedings, the decisions in the prior infringement suit do not bar the instant cancellation litigation. Soro notes that the original permanent injunction did not relate to the use of the CITIGROUP mark, only the CITICORP mark. Soro also asserts that he had priority use of the CITIGROUP mark, and that the mark is generic.

We review de novo a grant of a motion to dismiss. *Spain v. Brown & Williamson Tobacco Corp.*, 363 F. 3d 1183, 1187 (11th Cir. 2004). We review de novo a district court's res judicata or collateral estoppel determination.

EEOC v. Pemco Aeroplex, Inc., 383 F.3d 1280, 1285 (11th Cir. 2004)

A party to a cancellation proceeding who is dissatisfied with the decision of the TTAB may bring suit in federal district court. 15 U.S.C. 1071(a)(1), (b)(1); *Coach House Rest. v. Coach & Six Rests., Inc.*, 934 F.2d 1551, 1556 n.3 (11th Cir. 1991). "A district court may not reverse findings of the TTAB, unless the contrary is established by testimony which in character and amount carries thorough conviction. The district court can reverse if it concludes that the law applied by the TTAB was incorrect. Moreover, any equitable rulings rendered by the TTAB may be reversed if the TTAB abused its discretion." *Id.* at 1557 (internal quotation marks and footnotes omitted).

"In order to prosecute successfully a petition for cancellation, petitioner must prove: (1) [t]hat it has standing to petition for cancellation because it is likely to be damaged, and (2) that there are valid grounds for discontinuing registration." *Id.* at 1557; *see* 15 U.S.C. 1064. A mark may be cancelled on the basis of, among other things, (1) if the petition to cancel was filed within five years of the registration, any reason that the mark should not have been registered; or (2) at any time if,

inter alia, the mark has become generic, functional, or abandoned, or the mark was obtained or is being used fraudulently. 15 U.S.C. 1064(1), (3). To cancel registration under 15 U.S.C. 1052(d), a petitioner must show "(1) that the registered mark resembles petitioner's mark, (2) that the petitioner acquired trade identity rights in the mark before the registrant used the mark, and (3) that the registered mark is likely to cause confusion when used in connection with the services of registrant." *Coach House*, 934 F.2d at 1559 (footnotes omitted).

Res judicata, or claim preclusion, bars the filing of a claim that was raised or could have been raised in prior litigation where (1) there is a final judgment on the merits; (2) rendered by a court of a competent jurisdiction; (3) that involved the same parties or individuals in privity with them; and (4) involved the same cause of action. *Ragsdale v. Rubbermaid, Inc.*, 193 F.3d 1235, 1238-39 (11th Cir. 1999). "[T]he principal test for determining whether the causes of action are the same is whether the causes of actions are the same, a court must compare the substance of the actions, not their form. It is now said, in general, that if a case arises out of the same nucleus of operative fact, or is based upon the same factual predicate, as a former action, that the two cases are really the

same 'claim' or 'cause of action' for purposes of res judicata." *Id.* at 1239 (internal quotation marks and citation omitted). The only aspect of res judicata in question here is whether the prior litigation between Soro and Citigroup involved the same claim or cause of action.

Collateral estoppel, or issue preclusion, bars re-litigation of issues actually litigated and necessary to the judgment of prior litigation when the party against whom the earlier decision is asserted had a full and fair opportunity to litigate in the earlier proceeding. *Precision Air Parts, Inc. v. Avco Corp.*, 736 F.2d 1499, 1501 (11th Cir. 1984). "There are several prerequisites to the application of collateral estoppel: (1) the issue at stake must be identical to the one involved in the prior litigation; (2) the issues must have been actually litigated in the prior suit; (3) the determination of the issue in the prior litigation must have been a critical and necessary part of the judgment in that action; and (4) the party against whom the earlier decision is asserted must have had a full and fair opportunity to litigate the issue in the earlier proceeding." *I.A. Durbin, Inc. v. Jefferson Nat'l Bank*, 793 F.2d 1541, 1549 (11th Cir. 1986). The only aspect of collateral estoppel in question here is whether the issues in the prior proceedings were identical to the issues in the instant case.

After careful consideration of the briefs of the parties, and thorough review of the record, we find no reversible error.

The district court erred in determining that res judicata barred Soro's complaint. The prior litigation regarded only whether trade names used by Soro infringed on the CITICORP mark and an injunction directing Soro not to use trade names similar to the CITICORP mark. The instant case concerns whether Citigroup had the right to federally register the CITIGROUP mark. These are not the same causes of action and, therefore, res judicata is not applicable.

The district court correctly determined that collateral estoppel was applicable to the issue of priority use, but erred in determining that this barred the entirety of Soro's complaint. The issue of priority use was collaterally estopped as a result of the 2003 contempt order in the prior litigation between Soro and Citigroup. However, in the instant case Soro asserted that registration of the CITIGROUP mark should be cancelled because the term was generic, an independent basis for cancellation that had not been previously litigated by these two parties.

We may affirm on any ground supported by the record. *Bircoll v. Miami-Dade County*, 480 F.3d 1072, 1088 n.21 (11th Cir. 2007). Here, the TTAB correctly determined that Soro did not have standing to file the original petition for cancellation, and the district court's dismissal of Soro's complaint may be affirmed on this ground. To prevail on a petition for cancellation, a petitioner must show that "it has standing to petition for cancellation because it is likely to be damaged." *Coach House*, 934 F.2d at 1558; *see* 15 U.S.C. 1064. A petitioner has to show that he has a real commercial interest in the disputed mark, and a reasonable basis for the belief that he would be damaged by the registration of the mark. *Chem. New York Corp. v. Conmar Form Sys, Inc.*, 1 U.S.P.Q.2d 1139, 1142 (TTAB 1986). Here, Soro is the subject of a permanent injunction that prohibits him from using the word "Citigroup" in providing financial services. Because of this prohibition, Soro lacked a legitimate commercial interest in the CITIGROUP mark[1]. Accordingly, we affirm.

AFFIRMED.

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[1] Soro additionally argues the applicability to the TTAB of the 10-day period identified in Fed. R. Civ. P. 56(c). In light of Soro's lack of standing, any error in this regard was harmless.

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA
CASE NO. 06-61449-CIV-SEITZ/MCALILEY

LU SORO d/b/a CITIGROUP,
Plaintiff,

v.

CITIGROUP,

Defendant.

ORDER DENYING PLAINTIFF'S MOTION FOR RECONSIDERATION

THIS MATTER is before the Court on Plaintiff's Motion for Reconsideration [DE-36] of this Court's July 17, 2007 Order Granting Defendant's Motion to Dismiss [DE-35]. The Court has reviewed the parties' papers and the relevant portions of the record. Upon due consideration, the Court shall deny the motion.

Courts have recognized three grounds justifying reconsideration of an order: (1) an intervening change in controlling law; (2) the availability of new evidence; and (3) the need to correct clear error or manifest injustice. *See Wendy's Int'l, Inc. v. Nu-Cape Constr, Inc.*, 169

F.R.D. 680, 684 (M. D. Fla. 1996); *see also Sussman v. Salem, Saxon & Nielsen, P.A.*, 153 F.R.D. 689, 694 (M.D. Fla. 1994). Because "reconsideration of a previous order is an extraordinary remedy to be employed sparingly," only a change in the law, or the facts upon which a decision is based, will justify a reconsideration of a previous order. *See Sussman*, 153 F.R.D. at 694. Moreover, a motion for reconsideration cannot be used as a vehicle for presenting authorities available at the time of the first decision or to reiterate arguments previously made. *Z.K. Marine, Inc. v. M/V Archigetis,* 808 F. Supp. 1561, 1563 (S.D. Fla. 1992).

Here Plaintiff has not demonstrated any intervening change in the controlling law or the availability of new evidence. It does not point to any new fact or case law unavailable when the Court entered its July 17th Order. Thus, the Court assumes that Plaintiff is arguing there is a need to correct clear error or manifest injustice. Plaintiff's argument misses its mark.

In support of its contention that this Court committed clear error, Plaintiff reiterates the same arguments presented in its opposition to Defendant's motion to dismiss and rejected by this Court. Again, for res judicata purposes, the judgment that must be valid is the prior

judgment. Judge Spellman's and Judge Lenard's prior decisions were indisputably final. Judge Spellman found that Citicorp had established priority over the CITICORP mark, and he issued a permanent injunction against Plaintiff's use of that mark, or any other confusingly similar mark. Indeed, in her May 14, 2003 Order, Judge Lenard specifically ruled that the terms of Judge Spelling's injunction prohibited Plaintiff from using the CITIGROUP mark. This Court's July 17, 2007 Order stands. Accordingly, it is hereby

ORDERED that Plaintiff's Motion for Reconsideration [DE-36] is DENIED.

DONE AND ORDERED in Miami, Florida, this 7th day of August, 2007.

PATRICIA A. SEITZ
UNITED STATES DISTRICT JUDGE

cc: All Counsel of Record

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA
CASE NO. 06-61449-CIV-SEITZ/MCALILEY

LU SORO d/b/a CITIGROUP
Plaintiff,

v.

CITIGROUP, INC.,
Defendant.

ORDER GRANTING DEFENDANT'S MOTION TO DISMISS AND CLOSING CASE

THIS MATTER is before the Court on Defendant Citigroup, Inc.'s. Motion to Dismiss Plaintiff's Amended Complaint [DE-26]. Defendant seeks to have this case dismissed with prejudice on the grounds that the claims asserted in Plaintiff's Amended Complaint are barred by res judicata and/or collateral estoppel. The Court has reviewed the parties' papers and the relevant portions of the record, and will grant Defendant's motion.

I. FACTUAL AND PROCEDURAL BACKGROUND

Plaintiff's Amended Complaint is an appeal of an adverse ruling by the Trademark Trial and Appeal Board ("TTAB") on April 25, 2006, wherein the TTAB granted summary judgment in Defendant's favor on Plaintiff's Petition to Cancel the CITIGROUP trademark. This appeal stems from legal disputes dating as far back as 1985.

A. The Permanent Injunction Against Soro and His Company, Citigroup Mortgage

On August 26, 1985, Citicorp, Defendant's predecessor, sued Lu Soro's mortgage company, Citicorp Mortgage Company, Inc., alleging: (1) infringement of Citicorp's federally registered and famous CITI trademarks, including CITICORP; (2) false designation of origin under section 43 (a)(1) of the Lanham Trademark Act of 1946, 15 U.S.C. 1125(a)(1); (3) unfair competition under Florida common law; (4) and injury to business reputation under Florida Statues 495.141. (Ex. B to Plevan Aff. And DE-1 in Case No. 85-2962-CIV-SPELLMAN.) In early 1987, Citicorp amended its Complaint to add Lu Soro as an individual defendant. (Ex. B to Plevan Aff.)

On September 8, 1987, Judge Eugene P. Spellman, of this District, entered Summary Final Judgment on all counts in favor of Citicorp. (Ex. A to Plevan Aff.) Judge Spellman ordered, in relevant part, that Defendants be permanently enjoined from:

> Directly or indirectly...(b) using CITICORP as a part of a name or mark or using any other name or mark confusingly similar to CITICORP, in connection with any business which Defendants conduct, own or control; ...and (d) performing any actions or using any words, names, styles, titles, or marks, which are likely to cause confusion, to cause mistake or to deceive; or to otherwise mislead the trade or public into believing that Plaintiff and Defendants are one and the same or are in some way connected; ...or are likely in any way to lead the trade or the public to associate Defendants with Plaintiff....

(*Id.* At 2-3.)

Soro filed a *pro se* appeal of Judge Spellman's decision, on behalf of himself and

Citicorp Mortgage. (Ex. B to Plevan Aff. At 1.) The United States Court of Appeals for the Eleventh Circuit dismissed the appeal as to Citicorp Mortgage for lack of jurisdiction, and reversed and remanded Judge Spellman's decision as to Soro. (*Id.*) On remand, Judge Spellman again granted summary judgment in favor of Citicorp against Soro, and found that Soro's use of the mark CITICORP constituted trademark infringement and that Citicorp had prior rights to the mark. (Id. At 4-9.) In 1990, the Eleventh Circuit affirmed this judgment. *Citicorp v. Citicorp Mortgage Co.*, 898 F.2d 158 (11th Cir. 1990), *cert. denied*, 498 U.S. 854 (1990).

Initially, Soro refused to comply with the terms of the injunction, and Judge Spellman issued a warrant for his arrest. (See Ex. C to Plevan Aff. At 5.) Soro was arrested on November 28, 1988. (*Id.*) Eventually, Soro changed his company's name from Citicorp Mortgage Company to Soro Mortgage Company to purge himself of contempt and gain his release from prison. (See Ex. D to Plevan Aff. At 2.) In the early 1990's, Soro tried unsuccessfully to have the litigation reopened.

B. The 2000 Cancellation Proceeding Before the TTAB and Second Contempt Order

On December 19, 2000, Soro filed a Petition to Cancel Citicorp's registered CITIGROUP mark with the TTAB, and for the first time, raised the issue of his alleged prior use of the CITIGROUP mark. (Def.'s Mot. To Dismiss at 5; *see also* Ex. G to Plevan Aff. At 1.) In his petition, Soro alleged that he was the prior user of the CITIGROUP mark in connection with his mortgage business and accordingly owned the mark based on such prior use. (Ex. G to Plevan Aff. At 1.)

During the 2000 TTAB cancellation proceedings, Citicorp moved (1) to reopen the litigation in this Court on the ground that Soro had produced documents evidencing actual use of the name "Citigroup;" and (2) for an order finding Soro in contempt of Court. (Mot. To Dismiss at 5.) As a result, the TTAB cancellation proceedings were suspended while the contempt proceedings moved forward before United States District Judge Joan Lenard, with assistance from United States Magistrate Judge Andrea Simonton. (Ex. G to Plevan Aff. At 2)

In her Report and Recommendation, Magistrate Judge Simonton found that "Soro's claim that he has been using 'Citigroup' since January 5, 1976 [was] incredible, and unsupported by any credible evidence," and that his use of the name Citigroup Mortgage Company "is likely to cause confusion, to cause mistake, or to otherwise mislead the public into believing that his company and the Plaintiff are one and the same or are in some way connected, which is also a violation of the injunction." (Ex. C to Plevan Aff. At 14, 18.) Judge Lenard adopted the Magistrate Judge's Report and Recommendation. (Ex. D to Plevan Aff.) In addition, Judge Lenard found that "Soro had ignore[d] the procedural context of [the] case, which [wa]s crucial because the law places a higher burden on a party who has already been enjoined from using a name or mark." (*Id.* at 9) Accordingly, on May 14, 2003, Judge Lenard held Soro in contempt of the permanent injunction. (*Id.* at 13.) In 2004, the Eleventh Circuit affirmed Judge Lenard's contempt decision. (Ex. E to Plevan Aff.) Thereafter, the United States Supreme Court denied Soro's petition for writ of certiorari. (Ex. F to Plevan Aff.)

C. Soro's lack of Standing to Bring Cancellation Proceedings Before the TTAB

After the Eleventh Circuit affirmed Judge Lenard's contempt decision, Citicorp moved for summary judgment in the TTAB cancellation proceedings. (Ex. G to Plevan Aff. At 2.) It argued that, in light of Judge Lenard's decision, Soro had no standing to prosecute a cancellation proceeding relating to the CITIGROUP mark, and that in any case, Soro was collaterally estopped from maintaining the TTAB proceeding. (*Id.*) On April 24, 2006, the TTAB granted Citicorp's motion, noting in part:

> The district court decision in the contempt proceeding established that any use by Soro of the mark or trade name CITIGROUP violates the terms of the permanent injunction because CITIGROUP is "confusingly similar to and not a safe distance from the world-famous 'CITICORP' mark. Therefore, we find that there is no genuine issue of material fact that Soro is prohibited by the terms of the permanent injunction from using Citicorp or any mark or trade name confusingly similar, which includes the mark or trade name "Citigroup." As a result, under the

> terms of the permanent injunction, **Soro, as a matter of law, has no standing to maintain this proceeding because he lacks a legitimate commercial interest in the CITIGROUP mark and cannot prevail herein.**

(Ex. G. to Plevan Aff. at 8-9.) (emphasis added) (citations and footnote from original omitted). On July 25, 2006, Soro moved for reconsideration, which the TTAB denied. (Ex. H to Plevan Aff.) Soro later moved for clarification, which the TTAB denied on September 6, 2006. (Ex. I To Plevan Aff.)

D. Soro's Appeal of the TTAB's Decision

On September 25, 2006, Plaintiff filed a *pro se* Notice of Appeal with this Court [DE-1]. In the notice, Plaintiff alleged that "[in] trademark law 'first user' has ultimate rights not the first to register it, and a federal registration is not need[ed] to have a common law rights to that mark." (Pl.'s Notice of Appeal.) In support of the claim, Plaintiff attached a list of business names that incorporate a variation of the word "CITI' into their names. (Exs. A, B, and C to Pl.'s Notice of Appeal.)

On April 24, 2007, with assistance of counsel, Plaintiff filed its Amended Complaint, which urged this Court to: (1) reverse the findings of the TTAB cancellation proceedings; (2) order the cancellation of Defendant's registration of the "CITIGROUP" mark; and (3) find that "CITIGROUP" has become generic and/or diluted by wide spread use of the term "CITI." Plaintiff stated that "the TTAB failed to consider the district court's findings that the Plaintiff was found to have priority with respect to the use of CITIGROUP." (Pl.'s Am. Comp. 14.) However, Plaintiff provided no evidentiary support for this last statement. Furthermore, Plaintiff stated that, if the TTAB were to hear its argument regarding priority and the likelihood of confusion regarding the mark CITIGROUP, then the TTAB may find that he has standing to pursue the cancellation proceeding. (*Id.* 14-16.) Plaintiff also sought to submit further evidence to this Court demonstrating that the wide use of "CITI" coupled with various terms and phrases has diluted the mark "CITIGROUP." (*Id.* 17-18.)

E. Defendant's Motion to Dismiss Plaintiff's Amended Complaint

On April 27, 2007, Defendant moved to dismiss on the grounds that the doctrines of res

judicata and/or collateral estoppel bar Plaintiff's Amended Complaint. In opposition to the motion, Plaintiff argues that neither collateral estoppel nor res judicata bars the "appeal of the TTAB decision where the TTAB granted the Defendant's summary judgment based solely upon the lack of standing." (Pl.'s Opp'n to Def.'s Mot. To Dismiss at 1, DE-33.) Plaintiff further asserts that it has a "legitimate commercial interest in the use of CITIGROUP." (*Id.* at 1.) Plaintiff also contends that res judicata does not apply to the present case because it "has not previously sought appeal of the Cancellation No. 92031572 Decision." (*Id.* at 3.) Finally, Plaintiff argues that "collateral estoppel does not apply to the present case, because [it] seeks a review of the TTAB's decision which was based on standing." And the "prior litigation cited by Defendant fails to address the issue of standing as rendered in the [92031572] proceeding." (*Id.* at 5-6)

III. LEGAL STANDARD

Federal Rule of Civil Procedure 12(b)(6) provides that dismissal of a claim is appropriate when "it is clear that no relief could be granted under any set of facts that could be proved consistent with the allegations." *Blackstone v. Alabama*, 30 F. 3d 117, 120 (11th Cir. 1994). A

court may dismiss a complaint for failure to state a claim only if it is clear that no relief can be granted under any set of facts that could be proved consistent with the allegations. *See Hishon v. King and Spalding*, 467 U.S. 69, 73 (1984). When the claims at issue are barred by the doctrines of res judicata or collateral estoppel, courts will grant a motion to dismiss. *Conopco, Inc. v. Roll Int'l*, 231 F.3d 82, 86 (2d. Cir. 2000) ("Dismissal under Fed. R. Civ. P. 12 (b)(6) is appropriate when a defendant raises claim preclusion...and it is clear from the face of the complaint, and matters of which the court may take judicial notice, that the plaintiff's claims are barred as a matter of law"); *see also Aquatherm Indus. v. Fla.Power & Light Co.*, 84 F.3d 1388, 1391-95 (11th Cir. 1996) (affirming dismissal of Lanham claim on res judicata grounds).

Res judicata, or claim preclusion, forecloses relitigation of matters that have already been litigated or could have been litigated in an earlier suit, if the defendant establishes four elements. *I.A. Durbin, Inc. v. Jefferson Nat'l Bank*, 793 F. 2d 1541, 1549 (11th Cir. 1986). Those are: 1) a final judgment on the merits; 2) a decision rendered by a court of competent jurisdiction; 3) identical parties (or those in privy with them) in both suits; and 4) the same cause of action in both cases. *Id.*

Collateral estoppel, or issue preclusion, forecloses relitigation of a factual or legal issue litigated or decided in a previous suit. *Id.* Four elements must also be established for collateral estoppel:

> 1) the issue at stake must be identical to the one involved in the prior litigation; 2) the issue must have been actually litigated in the prior suit; 3) the determination of the issue in the prior litigation must have been a critical and necessary part of the judgment in that action; and 4) the party against whom the earlier decision was asserted must have had a full and fair opportunity to litigate the issue in the earlier proceeding.

Id.

IV. DISCUSSION

Judge Spellman's permanent injunction enjoins Soro from "**using CITICORP as a part of a name or mark or using any other name or mark confusingly similar to CITICORP**, in connection with any business which Defendants conduct, own or control." (Ex. A to Plevan Aff. at 2) (emphasis added).

Plaintiff ignores the fact that both Judge Spellman's permanent injunction and Judge Lenard's contempt finding bind this Court. To permit Plaintiff to provide new evidence in the attempt to establish its prior use of the CITIGROUP trademark would be to permit it to re-litigate both Judge Spellman's and Judge Lenard's prior final judgments which found he did not have priority of use of the CITI trademarks.

Plaintiff argues that res judicata does not apply to the present case because it has not previously sought an appeal of the TTAB's Cancellation No. 92031572 Decision. This argument makes no sense. It does not matter that Plaintiff has not previously appeale3d the TTAB's cancellation decision. The doctrine of res judicata requires this Court to determine if any prior, final judgments – issued by a court of competent jurisdiction – exist to bar the instant appeal. Here, Judge Spellman's summary judgment/preliminary injunction order and Judge Lenard's contempt order were both final judgments issued by courts of competent jurisdiction, and Plaintiff has completely exhausted the appellate process as to both decisions. Soro, his mortgage company, and Citigroup (formerly Citicorp) are the same parties that were involved in the prior actions, and the present case arises from the same

nucleus of operative facts as were alleged in both the injunction and contempt proceedings – namely whether Plaintiff was the first to use, and therefore owned, the CITICOPR and CITIGROUP trademarks. Accordingly, the doctrine of res judicata applies to bar Plaintiff's current claims.

Alternatively, the doctrine of collateral estoppel also bars Plaintiff's claims. As already discussed, the issue Plaintiff has raised before this Court is identical to that litigated and decided first in 1988 by Judge Spellman and then in 2003 by Judge Lenard: Plaintiff's alleged priority of use of the CITICORP/CITIGROUP trademarks. As the dispositive issue in those proceedings, priority of use was a critical and necessary part of the judgments, and as the decisions in those proceedings show, Plaintiff had a full and fair opportunity to present evidence on the issue.

IV. CONCLUSION

The foregoing discussion shows that the doctrines of res judicata and collateral estoppel bar Plaintiff's Amended Complaint. Accordingly, it is hereby

ORDERED that:

(1) Defendant's Motion to Dismiss Plaintiff's Amended Complaint [DE-26] is GRANTED

(2) All pending motions not otherwise ruled upon in this Order are DENIED AS MOOT; and

(3) This case is CLOSED.

DONE and ORDERED in Miami, Florida this 17th day of July, 2007.

PATRICIA A. SEITZ
UNITED STATES DISTRICT JUDGE

Cc: All counsel of Record

APPENDIX E

UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	*Citicorp
Serial No.:	*75462565
Mark:	*Citigroup
Class:	*36
Allowed:	April 18, 2000
Our Ref:	*14345/1280

STATEMENT OF USE

Box ITU
FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Applicant is the owner of the mark sought to be registered and has adopted and is now using in commerce the above mark on or in connection with all goods and/or services identified in the Notice of Allowance for the application and request that said mark be registered in the United States Patent and Trademark Office on the Principle Register established by the Act of July 5, 1946.

The mark was first used on the goods or services anywhere at least as early as April 6, 1998 and in commerce at least as early as October 8, 1998.

One specimen showing the mark as currently used in commerce is presented herewith.

"Express Mail" mailing label No. TB319294228 US Date of Deposit June 15, 2000. I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

Delayne Bell

DECLARATION

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the owner; and all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true. By: Anne Moses